

REMARKS

Introduction

Claims 1-16 are pending and stand rejected. Claims 1-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Published Application 2004/0264947A1 to Okada in view of U.S. Published Application No. 2003/0126201 to Hoang. Claims 8-16 were rejected under 35 U.S.C. §103(a) over Okada in view of U.S. Patent No. 6,233,695 to Ahn. The rejections as they may apply to the claims presented herein are respectfully traversed.

The Rejections of Claims 1-7 are Traversed

Amended claim 1 recites providing and storing in a memory a free memory list for an electronic storage medium. The free memory list identifies at least one free portion of memory. A portion of a file stored on the electronic storage medium is selected and the selected portion of the file is added to the free memory list.

The Office Action stated that Okada taught the use of a free memory list. The Applicant respectfully disagrees with this assertion. More specifically, the Examiner asserted that Okada's description that a "portion selected to be deleted" constituted a reference to such a list. See Okada, paragraphs 367 and 373. However, these paragraphs only mention the partial deletion of video object units (VOBUs). In the Okada system, the user only instructs the video editing apparatus to delete particular VOBUs (e.g., VOB#1 and VOB#2 in VOB#2). While these areas may be freed, there is nothing in Okada that teaches the availability is recorded in any sort of list. In other words, the memory space in Okada is directly freed and reallocated "on the fly" without the use of any type of memory list.

As for the Hoang system, a list of free memory blocks is apparently maintained (see Hoang, paragraph 41). However, there is no teaching or suggestion in Hoang as to selecting a portion of a file and adding that portion to the free memory list as recited in claim 1.

Since elements of claim 1 are not taught or suggested by either Okada or Hoang, it is submitted that claim 1 is allowable over the proposed combination of Okada and Hoang.

In addition, the Okada and Hoang references are not properly combinable since the combination would destroy an intended purpose of Okada. As mentioned, Okada is a system where no list is maintained and where memory deletions occur on the fly. In contrast, Hoang uses a list that identifies blocks of free memory. Modifying Okada to use a list would destroy

the operating principles of Okada because Okada does everything on the fly. The proposed modification would also significantly increase the overhead in the Okada system requiring, for example, new hardware and/or software. If a proposed modification destroys an intended purpose of one of the references in a proposed combination, then the references cannot be properly combined. See MPEP 2143.01.

Moreover, it is not proper to scour the prior art to find the individual elements of the Applicant's claims and then use the Applicant's own teachings to rearrange or combine the elements as claimed. See MPEP 2143.01. In the present case, Okada does not include a list and applying Hoang to Okada would simply use the Applicant's own teachings as the motivation for the combination/modification and this is improper. For these additional reasons, it is submitted that claim 1 is allowable over the proposed combination of Okada and Hoang.

Claims 2-7 depend upon claim 1. Since claim 1 is allowable, it is submitted that claims 2-7 are also allowable.

The Rejections of Claims 8-12 are Traversed

Claim 8 recites storing a media file on a memory of the personal video recorder. A signal for marking a starting flag for the media file is received and the starting flag indicates a starting point located anywhere in the media. A signal for marking an ending flag for the media file is received and the ending flag indicates an ending point located anywhere in the media. The memory of the personal video recorder that contains a portion of the media file between the starting flag and the ending flag is freed.

The Office Action stated that Okada taught the use of starting and ending flags. The Applicant respectfully disagrees with this assertion. More specifically, the Examiner cited paragraphs 367 and 373 of Okada for support of these assertions¹. However, as mentioned above, these paragraphs only mention the partial deletion of VOBUs and these areas are freed and their availability is not recorded in any sort of list or by using any flags. In other words, in this approach the memory space is directly freed and reallocated "on the fly" without the use of any type of flags.

As for Ahn, a presentation time stamp (PTS) flag and picture start code detecting flag (START) are used. However, the PTS flag only identifies whether data that includes a presentation time stamp has been detected. Ahn, col. 3, lines 55-57. The START flag indicates

whether data that includes a start code has been detected. *Id.* In other words, these flags simply do not indicate starting or ending points within the media.²

Since elements of claim 8 are not taught or suggested by Okada or Ahn, it is submitted that claim 8 is allowable over the proposed combination of Okada and Ahn.

Even if Ahn were viewed as having flags that indicated starting and ending points, it is submitted that Okada and Ahn are not properly combinable because the combination would destroy an intended purpose of Okada. More specifically and as mentioned above, Okada is a system where deletions are made without the use of flags. Modifying Okada to use flags would destroy the operating principles of Okada because Okada does everything on the fly. The proposed modification would also significantly increase the overhead in the Okada system requiring, for example, new hardware and/or software. If a proposed modification destroys an intended purpose of one of the references in a proposed combination, then the references cannot be properly combined. See MPEP 2143.01. For these additional reasons, it is submitted that claim 8 is allowable over the proposed combination of Okada and Ahn.

Claims 9-12 depend upon claim 8. Since claim 8 is allowable, it is submitted that claims 9-12 are allowable.

The Rejections of Claims 13-16 are Traversed

Claim 13 recites searching for a start program time stamp marking a starting point located anywhere in a video file. A search is performed for the first full image frame related to the start program time stamp. A search is performed for an end program time stamp marking an ending point located anywhere in the video file. A search is performed for a second full image frame related to the end program time stamp. A portion of the video file between the first full image frame and the second full image frame is deleted.

The Office Action admits that Okada does not include the use of time stamps that specify points located anywhere in the media as recited in claim 13 and attempts to use Ahn to correct this deficiency. However, Ahn only teaches the use of a single time stamp (a PTS) and there is no teaching in Ahn of what is included in the PTS let alone that the PTS indicates a starting or ending point anywhere in the media as recited in claim 13.

Since elements of claim 13 are not taught or suggested by Okada, it is submitted that

¹ These were the same paragraphs used to support the alleged teaching of a free memory list.

² The start code also does not indicate where the starting point is located and the PTS does not indicate where the

claim 13 is allowable over the proposed combination of Okada and Ahn.

Even if the PTS of Ahn were viewed as teaching time stamps indicating starting and ending points, it is submitted that Okada and Ahn are not properly combinable because the combination would destroy an intended purpose of Okada. More specifically and as mentioned above, Okada is a system where deletions are made without the use of time stamps. Modifying Okada to use time stamps would destroy the operating principles of Okada because Okada does everything on the fly. The proposed modification would also significantly increase the overhead in the Okada system requiring, for example, new hardware and/or software. If a proposed modification destroys an intended purpose of one of the references in a proposed combination, then the references cannot be properly combined. See MPEP 2143.01. For these additional reasons, it is submitted that claim 1 is allowable over the proposed combination of Okada and Ahn.

Claims 14-16 depend upon claim 13. Since claim 13 is allowable, it is submitted that claims 14-16 are allowable.

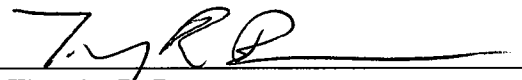
Conclusion

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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